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Thomas P. Foran

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REMARKS

Applicant appreciates the attention of the Examiner to the application. The Office Action of the Examiner of June 28, 2005 has been reviewed with care in the preparation of this response. The following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 8, 9, 12, 14-17, and 19-25 are pending. Claims 1-7 were withdrawn following an election pursuant to a restriction requirement by the Examiner and are now cancelled. The pending claims set forth a novel and non-obvious vial for use preferably in a level. Reconsideration and allowance of all pending claims is respectfully requested in view of the following remarks.

Claims 8 and 21 were rejected under 35 U.S.C. §102(b) as being anticipated by Lung (U.S. Patent No. 1,082,163). Claims 9, 12, 14-17, 19, 20, and 22-25 were rejected as being unpatentable under 35 U.S.C. §103(a) over Lung.

The proposed amendment amends claim 24. This amendment is fully supported by the specification to the application and does not include any new matter. Applicant now turns to the particular points raised by the Examiner in the Office Action of June 28, 2005.

Rejection of Claims 8 and 21 under 35 U.S.C. §102(b)

Independent claim 8 requires that the vial have a sleeve that is molded around a cylinder and indicia positioned on the outer surface of the cylinder that are bounded by the cylinder and the sleeve among other elements. Neither of these features are disclosed in Lung. Anticipation requires that the identical invention to that contained in a claim be described in a single prior art reference. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ 2d 1913 (Fed. Cir. 1989).

The Examiner in the Office Action points to outer tube N in Lung as disclosing a sleeve molded around a cylinder. Outer tube N is shown in the reference, however, as not being molded

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around the suggested cylinder, tube J, but rather having tube J nested within it. Quite distinct from having tube J over-molded, the ends of tube J are simply secured to tube N by plaster or cement and cushions of resilient material and packing rings are interposed between the outer surface of tube J and the inner surface of tube N. (Lung at pg. 1, lines 98-110).

The Examiner also points to threads V that hold sheets U to tube J as disclosing indicia bounded by both tube N and tube J. Lung teaches, however, that the threads V occupy corresponding scribes V' within tube J so that they are prevented from shifting. (Lung at pg. 2, lines 31-42). Moreover, packing rings R, as indicated above, firmly separate tube N from tube J and serve as cushions to prevent either tube from being broken from side thrusts being imparted to the assembly. As a consequence, threads V are simply surrounded but not bounded by tube N.

Since all of the limitations of claim 8 are not found in Lung, Applicant submits that the rejection of that claim has been overcome and asks that it and each of the claims dependent to it, including claim 21, be allowed.

Rejection of Claims 9, 12, 14 and 22 under 35 U.S.C. §103(a)

Claims 9, 12, 14 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lung. These claims are allowable at least by virtue of their dependency from claim 8 that traverses any rejection by the Examiner for the reasons stated above.

Obviousness under 35 U.S.C. §103(a) can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). In addition, any such combination or modification of the prior art must still teach or suggest each and every one of the claim limitations. MPEP §2143.

The Examiner acknowledges that Lung does not disclose a vial wherein the first and second materials are acrylic (claim 9), wherein the indicia is hot stamped onto the cylinder (claim

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14), or wherein the inner surface is machined to form a cavity having a desired shape (claim 22). The Examiner states only that it would have been obvious to one having ordinary skill in the art to select acrylic for the materials for an over-molded vial, to provide the cylinder of an over-molded vial with hot stamped indicia, and to provide the cavity of an over-molded vial with a machined inner surface such that it may have a desired shape. He specifically cites In re Leshin, 47 CCPA 911, 125 USPQ 416 (1960) in support of the proposition that it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the device. Although not directly relying upon In re Leshin in support of her rejections of claims 14 and 22, the Examiner appears to make a Leshin-like argument by stating that "one skilled in the art would change the method of forming in order to suit the needs of the user of the device ..."

The Examiner's reliance, however, on the decision in In re Leshin is misplaced. The ruling in that case is far more limited than the broad holding attributed to it by the Examiner. Appellant in that decision claimed a device for dispensing cosmetics in solid form. The device included a container made from molded plastic materials. Although the prior art showed a similar container of molded plastic and appellant conceded using well-known plastics in his device, appellate continued to contend that those claims limited to plastic were still patentable because he had to select the plastics used for his particular purpose. The court responded to this argument by ruling: "Mere selection of known plastics to make a container-dispenser of a type made of plastics prior to the invention, the selection of the plastics being on the basis of suitability for the intended use, would be entirely obvious; and in view of 35 U.S.C. 103 it is a wonder that the point is even mentioned." In re Leshin 125 USPQ at 417.

Claims 9, 14 and 22 are not directed to limitations where the point of novelty is no more than something comparable to the selection of a particular type of material for making a structure taught in the prior art from a class of material also taught in the prior art for that type of structure. In particular, Lung does not teach, describe or suggest cylinders, sleeves or vials formed from

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plastic resins, cylinders having hot-stamped printing or imagery, or cylinders having a cavity formed from a machined inner surface. Claims 9, 14 and 22 represent therefore anything but a mere matter of design choice. The Examiner has clearly not shown that the supposed motivation for the inventor to select the features constituting the claimed limitations from structures of a similar type and material is actually disclosed or taught by any piece of art prior to the date of the invention.

Although obviousness in view of a single reference can be established through modification of a prior art device such that it produces the claimed invention, there must still be some teaching, suggestion or motivation to do so found either in the reference itself or in the knowledge commonly available in the art. In particular, there must be more of a justification shown for modifying some piece of prior art than merely the fact that it happened to have been known at the time of the invention. The ability of a reference to be modified does not render the resultant modification obvious unless this prior art actually suggests the desirability of such a modification. MPEP §2143.01.

While it is true that an examiner may base an obviousness rejection upon common knowledge in the art, this is the case only if such a teaching is capable of being instantly and unquestionably demonstrated as being clearly "well-known" in the art. MPEP §2144.03. Whether or not the teachings relied upon by the Examiner, i.e., that one skilled in the art would change the type of material or change the method of forming to suit the needs of the user, satisfy this requirement is left unanswered and unsupported in the present Office Action.

A specific explanation as to why a skilled artisan would have been motivated to make a claimed modification is required to be set forth by the Examiner after each and ever rejection under 35 U.S.C. §103. MPEP §706.02(j). This requirement arises in part because of the type of hindsight that can often occur when there is first a disclosure by the Applicant of his invention. "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the

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case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F. 3d 1350 at 1357-1358; 47 USPQ 2d 1453 (Fed. Cir. 1998).

The Examiner makes mention in her rejections of claims 14 and 22 that the limitations added in those claims were somehow "not germane to the issue of patentability of the device itself" and that therefore these limitations were not being given "patentable weight." No authority is cited by the Examiner in the Office Action that either supports or clarifies her proposition that certain limitations have less "patentable weight" because they are somehow not germane to patentability.

Applicant believes that this position being taken by the Examiner is mistaken and that the limitation in each of these claims simply defines what the structure in question is and clearly sets forth definite boundaries as to the patent protection being sought. As a consequence, these limitations, like all claim limitations, must be shown as having been taught or suggested by the prior art for there to be support for their rejection on the basis of obviousness. Moreover, every word in those claims must be given consideration when judging their patentability against such prior art. MPEP §2143.03.

For all of these reasons, Applicant respectfully asks that the rejections of claims 9, 12, 14 and 22 be withdrawn and that each of these claims now be allowed.

Rejection of Claims 15-17, 19-20, and 23-25 under 35 U.S.C. §103(a)

Claims 15-17, 19-20, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lung. Claims 16-17, 19-20, and 23-25 are dependent to independent claim 15. Each claim includes limitations that are neither taught nor suggested by Lung.

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The Examiner asserts that Lung discloses a cylinder having a second material molded around it as set forth in claim 15. As explained above with respect to the allowability of claim 8, there is no teaching of this feature found anywhere within that reference. The "second material" pointed to by the Examiner is a tube N that has nested within it, secured by plaster, cushions and packing rings, a tube J, the supposed "cylinder."

Claim 15 is also directed to a vial that includes a cylinder whose inner surface is machined to form a cavity having a desired shape. There is no suggestion or motivation within Lung that would support a modification of tube J to arrive at this limitation. For at least the same reasons stated earlier with respect to the allowability of claim 22, there is a lack of an adequate showing by the Examiner of the obviousness of this requirement in view of the prior art. In addition, however, Fig. 7 of the cited reference suggests a tube J made from glass. This is supported as well by both the age of the reference (a date of publication of December 23, 1913) and the tube being referred to alternatively in the specification as a "bottle". Given the clear indication of the fragility of this bottle by the measures being taken to protect it that include using the surrounding structures P, Q, R, N, Lung clearly teaches against the bottle having any manner of machined inner surface to form its cavity. Applicant believes therefore that this rejection should also be withdrawn and asks that independent claim 15 and every claim depending from it be allowed.

In addition, however, claim 17 specifically includes the limitations that the cylinder is molded, that at least one marker ring is embedded into the outer surface of the cylinder, and the second material molded around the cylinder is molded around the marker ring such that the marker ring is enclosed between the first material of the cylinder and the second material. None of these features is disclosed or shown by Lung. The Lung reference teaches only that tube J is a spirit-containing bottle with a bubble inside it. Nothing is said or suggested as to how this tube is formed. The marker ring pointed to by the Examiner is a thread V tied around, not embedded

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into, the tube. And Lung fails to disclose in any way that tube J is over-molded with a second material, much less showing any molding around thread V so as to enclose it.

Claims 24, as amended, adds the limitation that the longitudinal cross-section of the desired shape of the cavity is curvilinear along its length. Claim 20 is dependent to claim 24 and limits the cavity to being barrel-shaped. Claim 25 is dependent to claim 20 and requires that the maximum diameter of the barrel-shaped cavity be positioned equidistant between two marker rings. Neither the specification nor the figures to the Lung reference disclose the cavity of tube J as being bounded by a curved inner surface along its length, much less one having a barrel shape with a maximum diameter between two marker rings. In particular, nothing is taught or suggested regarding the cavity of the tube other than for Figs. 4 and 5. These drawings simply show that this cavity is symmetrical along its length, the longitudinal cross-section seen in Fig. 4 disclosing a profile where the top of the inner surface of the tube is parallel with the bottom.

The Examiner acknowledges that Lung does not disclose a vial wherein the first and second materials are the same acrylic material and wherein the cylinder is solid and at a temperature less than the melting point of the material when the second material is molded around it (claim 16) or wherein the first material is polycarbonate and the second material is acrylic (claim 23). The Examiner simply states in support of her rejection of these claims that it would have been obvious to one having ordinary skill in the art to select or change the type of material comprising the first and second materials of an over-molded vial or to provide a cylinder of an over-molded vial that is solid and at a lower temperature than the material's melting point when the second material is molded around it in order to suit the needs of the user of the device.

The Examiner's reliance once again on the decision in In re Leshin is misplaced. As stated above with respect to the allowability of claims 9, 14 and 22, obviousness in view of a single reference can be established through modification of the prior art device so as to produce the claimed invention only when there is some teaching, suggestion or motivation to do so found either in the reference itself or in the knowledge generally available to one of ordinary skill in the

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art. There must be more of a justification for modifying the reference device than solely the fact that it happened to have been known at the time of the invention. In addition, the mere fact that a reference can be modified does not then render the resultant modification obvious unless the desirability of this modification had been disclosed or suggested by the prior art. MPEP §2143.01.

There is no showing in the present Office Action, however, of the specific reasons or motivation within Lung that would support the suggested modifications of the features in that reference that are relied upon by the Examiner for her rejections of claims 16 and 23. For the Examiner to simply call upon some subjective basis of engineering or design expediency in order to provide the necessary motivation for the selection and modification of the cited reference is simply not the objective explanation required to be set forth under MPEP §706.02(j), but is rather another exercise in prohibited hindsight.

Moreover, as explained earlier, the ruling in In re Leshin is far more limited than the broad holding attributed to it by the Examiner. Claims 16 and 23 are not directed to limitations where the point of novelty is no more than something comparable to the selection of a particular type of material for making the structure taught in Lung from a class of material also taught in Lung for that type of structure. In particular, Lung does not teach, describe or suggest cylinders, sleeves or vials formed from polymeric materials or a cylinder that is solid and at a temperature less than the melting point of the material forming it when the same material is molded around it. Claims 16 and 23 therefore do not represent a mere design choice by the Applicant since there is no showing in the Office Action that the features constituting the claimed limitations are simply selected from structures of a similar type and material that are already disclosed by the prior art cited by the Examiner.

Although an examiner may base an obviousness rejection upon common knowledge in the art, such a teaching must be subject to instant and unquestionable demonstration as being "well-known" in the art. MPEP §2144.03. Whether or not the teachings relied upon by the

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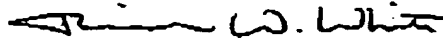
Examiner in rejecting claims 16 and 23 satisfies this requirement is left unaddressed in the present Office Action. Absent such a showing, there is lacking a prima facie case of obviousness upon which the Examiner can base her rejections of these claims.

Applicant believes therefore that the specific rejections of claims 16-17, 20, and 23-25 have been overcome and that each of these claims should now be allowed.

Conclusion

Applicant's invention, as set forth in the pending claims, represents a highly novel vial as is used in levels. Applicant believes that now pending claims 8, 9, 12, 14-17, and 19-25 each have elements not disclosed or suggested in the prior art. Applicant respectfully submits that all rejections in the Office Action have been traversed by amendment and argument, placing the application in condition for allowance. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain. If any fees are due, please debit Deposit Account 10-0270 and inform the undersigned.

Respectfully submitted,



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